

**REMARKS*****Claim Amendments***

Claim 10 has been cancelled, without waiver or prejudice, as being in a "use" form not customary under U.S. practice. New method claims 11 to 17 have been added. Support for the added claims is found throughout the application as filed, and particularly as follows:

- Support for new claims 11, 12, 13 and 14 is found in original claim 10, and in the specification, *inter alia*, at page 4, lines 26-31, and at page 16, line 18 to page 17, line 7.
- Support for new claim 15 is found in original claim 10, and in the specification, *inter alia*, at page 4, lines 26-31, and at page 16, line 18 to page 17, line 7.
- Support for new claim 16 and 17 is found in the specification, *inter alia*, at page 4, lines 26-31, and at page 16, line 18 to page 17, line 7.

Compound claims 5 and 6 have been amended to made them dependent only on claim 1, thereby avoiding possible improper multiple dependencies of later claims.

Process claim 8 has been amended, without waiver or prejudice, for purposes of clarification as discussed further below.

No new matter has been added by the amendments to claims 5, 6 or 8, or by the addition of new claims 11 to 17, and entry of these amendments is believed to be in order and is respectfully requested. Following entry of these amendments, claims 1-9 and 11-17 remain pending in this application.

***Claim Rejections - 35 USC 112***

Process claims 8 was rejected under 35 USC § 112, first paragraph (enablement), on the assertion that applicant does not disclose the steps involved in converting a compound of

formula (I) into another compound of the formula (I), as well as by removing any protective groups.

Upon review of claim 8 as filed, it appears that its wording can be clarified (which might be a source of the present rejection) without changing the intended scope of the claim. Specifically, the subjective preamble to steps i), ii) and iii), "and thereafter if necessary," has been changed to "and thereafter optionally," making clear the intended meaning that any or all of these further steps could be carried out, but need not be carried out, to make a compound within the scope of compound claim 1. Additionally, to avoid any technical argument that the conjunctive "or" might imply that only one of these optional steps may be carried out, the "or" has been replaced with "and/or" to make absolutely clear that one or more of these optional steps may be carried out in the course of the claimed process.

Moreover, in order to expedite prosecution of this application to allowance, original optional step i) of claim 8 has been removed, and original optional steps ii) and iii) have been renumbered as optional steps i) and ii), respectively. Removing the specific recitation that one compound within the scope of claim 1 may optionally be converted into another compound within the scope of claim 1 by known and conventional means, is not seen to alter the scope of this process claim in any respect.

However, the Examiner's assertion that the optional step of "removing any protective groups" is not enabled is respectfully traversed. Persons skilled in this art are well aware of the use of protecting groups when carrying out reactions such as set out in claim 8, for instance to protect highly reactive hydroxy or carboxyl groups from unintended reactions. Appropriate protecting groups and means for their removal are well within the skill of this art. Nevertheless, the present specification provides ample exemplary disclosure of suitable

protecting groups and their removal at page 11, line 13 through page 12, line 4. It is respectfully submitted that persons skilled in the art, particularly in view of the guidance provided by the specification, are quite able to identify and use appropriate protecting groups without undue experimentation.

Claim 10 was rejected under 35 USC § 112, second paragraph, as indefinite for being in a "use" form not generally acceptable under U.S. practice. This ground for rejection has been obviated by the cancellation of claim 10, without prejudice. New claims 11 through 17 have been added, which are in an appropriate method format. Support for these new method claims has been itemized above.

In view of the above, it is respectfully requested that all of the asserted grounds for rejection of claim 8 be withdrawn.

***Supplemental Information Disclosure Statement***

The Examiner's attention is called to the Supplemental Information Disclosure Statement submitted herewith, including a form PTO-1449 and a copy of each document cited therein. This Supplemental Information Disclosure Statement also includes a current listing of pending applications and granted patents of applicants' assignee that are believed to be technically related to the subject matter of the present application.

This Supplemental Information Disclosure Statement supplements the first PTO-1449 that was filed with this application on July 18, 2002. The first PTO-1449 formally cited the documents cited in the International Search Report, and consideration of those documents was acknowledged by the Examiner by return of an initialed copy of the first PTO-1449 with

the present Action. The Supplemental Information Disclosure Statement cites and provides copies of additional documents that have been cited in related applications.

The Examiner will note from the list of related U.S. patent applications included in the Supplemental Information Disclosure Statement that four of the related applications have now issued as patents. These are:

U.S. Serial No.	U.S. Patent No.	Previously Cited PCT Publication No.
09/485,061	6,441,004	WO 99/07351
09/485,107	6,288,103	WO 99/07678
09/626,241	6,291,507	
09/626,378	6,479,527	

For the Examiner's convenience, a copy of each of these issued U.S. Patents is provided with the Supplemental Information Disclosure Statement. However, as shown on the above table, two of the corresponding published PCT applications were cited on the original PTO-1449, and have already been considered by the Examiner.

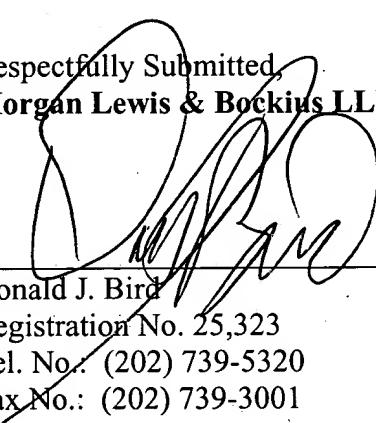
Consideration of the Supplemental Information Disclosure Statement, including the cited documents and related applications, is respectfully requested at the time that this application is next taken up for examination.

### *Conclusion*

The allowability of compound claims 1-7 and pharmaceutical composition claim 9 in the present Action is noted with appreciation. It is believed that the above amendments and the foregoing remarks fully address and overcome the grounds for rejection of claim 8, and

the rejection of claim 10 has been obviated by its cancellation. New claims 11-17 are believed to appropriately claim the disclosed methods for using the claimed compounds, and are fully supported by the specification as itemized above. Therefore, it is believed that all claims are now in condition of allowance, and a notice to that effect is respectfully requested.

Respectfully Submitted,  
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**VERSION WITH MARKINGS TO SHOW CHANGES**

IN THE CLAIMS:

Claim 10 has been cancelled, without prejudice, and new claims 11-17 have been added.

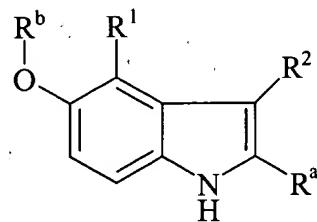
Claims 5, 6 and 8 have been amended, without prejudice, as follows, wherein deleted material is shown by **[bold text within brackets]** and added material is shown by **bold underlined text**:

5. (Amended) A compound according to claim 1 [any one of the preceding claims] wherein T is  $-\text{CH}_2-$ .

6. (Amended) A compound according to claim 1 [any one of the preceding claims] where  $\text{R}^3$  is carboxy.

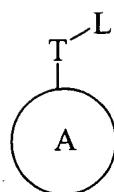
8. (Amended) A process for preparing a compound according to claim 1 which process comprises:

a) reacting compounds of formula (II):



(II)

where  $\text{R}^a$  is a group  $\text{R}^3$  as defined in claim 1 or protected form of a group  $\text{R}^3$ ,  $\text{R}^b$  is hydrogen or a hydroxy protecting group, and  $\text{R}^1$  and  $\text{R}^2$  are as defined in claim 1, with a compound of formula (III):



**(III)**

where T and ring A are as defined in claim 1, and L is a displaceable group;  
and thereafter [if necessary] optionally:

- [i] converting a compound of the formula (I) into another compound of the formula (I);]**
- [ii] removing any protecting groups; and/or**
- [iii] forming a pharmaceutically acceptable salt or prodrug thereof.**